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SAGER, J. M.
EXAMINER

ART UNIT

PAPER NUMBER

11/09/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/918944

Applicant(s)

Sawyer et al

Examiner

M.A. Sager

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE Three(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on Dec 3, 1997
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21 ~~is/are~~ pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-21 ~~is/are~~ rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the disclosure lacks antecedent basis for feature of the random number generator 'indexes through each of the different prizes' (clm 8) and step of 'randomly indexing among different prizes... selection element' (clm 21).

Claim Objections

2. Claim 19-20 are objected to because of the following informalities: use of acronym 'LEDs' without use of light emitting diodes at first occurrence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term 'system' (clms 1 and 19, line 1 each) is indefinite for not clearly claiming the metes and bounds of the invention. Specifically, 'system' does not definitively claim either a process, machine or article of manufacture. However, for examination purposes, the claims will be examined as if claiming an machine or apparatus due to the claimed structure.

The phrases 'the primary game' (clm 1, line 6), 'the light emitting elements' (clm 1, lines 23-24), 'the time instant' (clm 8) each lack antecedent basis.

The phrase 'may be' (clm 19, line 7) and the term 'capable' (clm 13) is indefinite for not clearly claiming the metes and bounds of the invention by not clearly claiming the performance of the action following the cited phrase.

The phrase 'in accordance with rules of play' (clm 16, lines 6-7, clm 19, lines 17-18) is indefinite for attempting to claim steps for playing a game without definitively claiming the steps and further for claiming steps in an apparatus (*supra*) type claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7, 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al in view of Baerlocher et al. Regarding steps of claim 21, Forte discloses a system and method teaching 'attaching a prize display to the table' (6:52-61; 8:30-39), 'indicating on the prize display... points' for the various bonus levels (4:53-5:30; 8:30-39; 11:66-12:4), 'selectively lighting the indication... display' (4:53-5:30; 8:30-39; 11:66-12:4), 'positioning a player interface unit on the table' (figs. 1-20, ref. 22), 'displaying on each player interface unit the number of bonus points' (5:59-6:6, fig. 8, ref. 24), 'positioning a dealer interface unit on the table including dealer control elements' (figs. 1-20, ref. 20), and 'controlling the number of bonus points

displayed on each player interface unit by the dealer manipulating dealer control elements' (figs. 1-20, refs. 26, 28, 30, 32, 38, 223-224, 252), but fails to disclose a 'player prize selection element', 'activating... unit', 'randomly indexing... element' and 'selecting one of the randomly indexed prizes... element'. Alternatively, Forte discloses a display which displays bonus prize level messages on a signboard, but does not disclose a prize display that is used as a randomizer in selection of a random bonus prize. Baerlocher discloses a method and apparatus teaching a 'prize display' used as a randomizer for selection of a random bonus award (figs. 1-6), a 'player prize selection element on the player interface unit' (5:45-65), 'activating the player prize selection element on the player interface unit... unit' where 'by the dealer manipulating the dealer control elements... unit' is a recitation for the controller activating the bonus game (5:45-65), 'randomly indexing... element' (7:19-30; 10:1-6) and 'selecting one of the randomly indexed prizes... element' (5:45-65; 10:1-6) in order to increase player excitement with a random bonus prize and to entice players to play longer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a 'prize display... table', 'activating.... dealer interface unit', 'randomly indexing... element' and 'selecting one of the randomly indexed prizes... element' as taught by Baerlocher to Forte's system and method in order to increase player excitement with a random bonus prize and to entice players to play longer.

Alternatively, where 'by the dealer manipulating the dealer control elements... unit' is for a dealer to activate the bonus game, Baerlocher discloses the controller of the game machine controlling the activating and resetting elements for the bonus game; whereas, Forte teaches a

dealer acting as the controller for activating and resetting elements for the bonus game so the casino maintains control of the game. Therefore, it would have been obvious to add 'by the dealer manipulating the dealer control elements... unit' to Forte in view of Baerlocher in order for the casino to maintain control of the game.

Regarding features of claims 1-7 and 9-20, Forte discloses a system and method for playing a card game at a game table with at least a dealer while simultaneously playing an auxiliary bonus game (figs. 1-20) which teaches a player interface unit (ref. 22), a dealer interface unit (ref. 20) and a controller to track and count game events attached to a game table (3:41-6:6; 6:59-61; 8:30-39; 14:52-15:36, figs. 1-21), but fails to disclose elements/components for controlling and displaying the random selection of a bonus award such as a 'prize display' (clm 1), a 'controller connected to the prize display' and the player interface unit 'to control the light emitting elements... each player' (clm 1, lines 20 and 21-24), and a 'random number generator' (clms 7 and 19). Baerlocher discloses a method and apparatus which while simultaneously playing a wagering game (3:15-25; 5:36-42; 9:60-67) an auxiliary bonus game is played (3:50-4:11; 4:46-10:6) where the computer tracks the accumulation of a predetermined number of bonus game events such as the letters of a word or phrase and teaches an apparatus comprising elements/components for controlling, displaying and permitting selection of a random award such as a 'prize display' (figs. 1 and 4-6), a 'controller connected to the prize display' and the player interface unit 'to control the light emitting elements... each player' which includes a 'random generator' (2:55-61; 3: 26-34; 6:16-7:30) in order to increase player's excitement with randomized prize to thereby entice player's to play longer (figs. 1-6). Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to add a 'prize display', a 'controller connected to the prize display' 'to control the light emitting elements... each player' as taught by Baerlocher to Forte's system and method in order to increase player excitement with a random prize and to entice players to keep playing.

Alternatively, Baerlocher discloses a game method and apparatus for playing a wagering game (5:36-39) simultaneous with a bonus game which teaches tracking, controlling and displaying bonus events for completing a word or phrase of a predetermined number of letters in a gaming machine and a player interface unit for displaying the status of the bonus events where, upon a player reaching a threshold value, the player is awarded a random award (3:13-7:65, figs. 1-6), but Baerlocher fails to teach 'attached to the table' (clm 1, line 9), 'on the table' (clm 1, line 15), 'light emitting element' (clm 1, lines 12-13), LEDs (clm 19, line 7), and a 'dealer interface unit... including dealer control elements' (clm 2) since Baerlocher's apparatus is an individual game machine not played with a dealer at a gaming table. Forte discloses a game system and method teaching a card game apparatus which counts particular bonus events where, upon a player reaching a predetermined threshold value, the player is awarded a fixed bonus award or a portion of a jackpot (3:41-6:6; 14:52-15:36, figs. 1-21) with the apparatus being 'attached to the table' (fig. 1-20) and 'on the table' (figs. 1-20) to socialize game play with other players and a dealer and, further a 'dealer interface unit... including dealer control elements' (refs. 20, 22, 42) to control player interface unit and to display status of the game in accordance with the rules of the game. Thus, Forte teaches using a dealer to control game play of the card game as known in the art and to input counts of successive bonus events. Further, Forte teaches it is known to use light

emitting elements or LEDs on/in a display to indicate status of a game. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'attached to the table', 'on the table', 'light emitting element', 'LEDs', a 'dealer interface unit... including dealer control elements' as taught by Forte to Baerlocher's game method and apparatus in order to socialize game play by enjoining the game to a game table and including at least a dealer.

Steps of claim 21 parallel features of claims 1-7 and 9-20; therefore, the discussion above regarding claims 1-7 and 9-20 (supra) is incorporated herein for claim 21.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al in view of Baerlocher et al as applied to claim 7 above, and further in view of Heidel. Forte in view of Baerlocher disclose a system and method comprising claimed features (supra) except a 'time instant when the player control element is manipulated... generator'. Heidel discloses a wagering game which teaches a time-based method of generating game results based upon player input (5:43-6:43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'time instant... generator' as taught by Heidel to Forte's system and method in view of Baerlocher in order to generate a game result based upon the time of player input.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pascoe discloses an Electronic Wheel of Fortune device for randomizing events considered pertinent. Buckley and Supplement to IGWB are each pertinent for citing that gaming

trends include bonus games within wagering games and include adding bells and whistles to games to attract the new generation of wagerers.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Jessica Harrison, can be reached on (703) 308-2217. The fax phone number for this Group is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager
Patent Examiner
Nov. 4, 1998